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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,548	11/20/2001	Bernd Luhmann	tesa AG 478.2KGB	8904

27384 7590 02/05/2003

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-35 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 12-35 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☒ Certified copies of the priority documents have been received in Application No. 08/976,802

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

2. Claims 12-23 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,372,335B1. This is a double patenting rejection. Note that while applicants' independent claim 12 is both open ended with respect to the contents of the adhesive tape, and further contains a backing element that "comprises" a foam material, the scope of the claim is still identical with claim 1 of the patent even though subparagraph a) recites "a backing consisting of a single layer foam material". This is because this claim is also open ended with respect to the contents which may exist therein and consequently the scope of the claims of the newly presented application and applicants' earlier patent are identical. Additionally, although there are some definite differences in the language of method claims 11 and 12 of the patent and newly submitted method claims 22 and 23 upon closer inspection, it is seen that the two claims clearly read upon one

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another and therefore statutory 35 U.S.C. § 101 double patenting exists for these claims as well.

3. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 24-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,372,335B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation set forth in the last four lines of independent claim 24 is believed to be either an inherent property of the claimed genus of adhesive tapes set forth in claim 1 of the patent, or, alternatively, an obvious optimization to one of ordinary skill in the art, motivated by a desire to not have the formed article tear during use. Additionally, note that while claim 24 is open

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ended in its recitation of the adhesive tape, and also claims subelement a) "a backing comprising a foam material", the scope of this claim is still the same as that of claim 1 of the patent, for reasons described above.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 95/06691. The reference discloses (note particularly page 1, lines 6-9, line 21 - page 2 line 13, page 2 line 27 - page 3 line 10, page 8 lines 6-14, line 18 - page 9 line 3, page 10 lines 5-11, the Examples) an adhesive tape which forms a bond that can be redetached by pulling without residue or damage. The tape features a foam backing that is coated with a pressure sensitive adhesive and in certain embodiments (page 3, lines 1-6) features two adjacent foam layers each of which can preferably be as thin as about 5 mils, or 10 mils total. As such, the thickness of the foam backing could range from as thin as 10 mils to about 2000 mils, which clearly

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reads upon applicants' backing having a thickness of 200-600 microns. The fact that the tapes of the reference may "preferably be at least about 30 mils in thickness" still fails to negate the fact that the teachings of a reference are not limited to the preferred embodiments. Additionally, the foam is clearly believed to read upon the Young's modulus of elasticity parameter. Since the reference desires the material to be readily removed, it would have been obvious to have provided a pressure sensitive adhesive with the peel force claimed herein or to allow ready removability, particularly since the reference teaches substantially the same genus of adhesives that applicants contemplate. As such, applicants' arguments (page 11 of the preliminary amendment) regarding the focal point of the invention as "manipulating the adhesive composition" are not understood since the reference, as stated above, uses basically the same adhesives as do applicants (page 8 line 18 - page 9 line 3 of the specification).

Applicants further argue (Preliminary Amendment, page 9, lines 8-17) that a rejection based upon either inherency, or obviousness cannot stand. He further appears to continue on to state that if some parameter is inherent, then and only then must such element be necessarily present in the prior art. However, the Examiner must respectfully disagree, pointing out that he believes it is perfectly valid for an examiner to make a

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rejection where on the one hand the element is either inherent (i.e. anticipated), or, if it is not, that particular parameter may well be within the ordinary skill of the art. Finally, with respect to the dependent claims, these are substantially identical and as such are believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 24-35 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, the "whereby clause" in the last four lines of claim 24 is believed to be new matter. Applicants argued in their preliminary amendment of January 22, 2001 (Paper No. 11) in the parent application at page 10 that this whereby clause found support at "particularly Example 1, conveys the concept of a backing that would tear if not for the presence of the self-

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adhesive composition. Consequently, claim 25 does not introduce new matter". The Examiner respectfully disagrees. Applicants discuss the results of Example 1 in their specification at page 15, lines 11-22, and the Examiner believes that such discussion stands only for the proposition that the presence of a foam backing is better than no foam backing at all, and the same can also be said for the data set forth in Example 2. Therefore, although support may possibly exist, the Examiner has been unable to so determine it and must hold the whereby clause of claim 24 to be new matter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc  
January 28, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1368  
1700

*Daniel Zirker*